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10/759,634

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Daniel Richard Monroe

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10/16/2007

Brent E. Vecchia
Blakely, Sokoloff, Taylor & Zafman LLP
7th Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025

EXAMINER

TORRES, JUAN A

ART UNIT

PAPER NUMBER

2611

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/759,634

Applicant(s)

MONROE ET AL.

Examiner

Juan A. Torres

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 03/22/04 and 04/30/07.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

The information disclosure statements filed on 03/22/2004 and on 04/30/2007 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

These documents have not been found in the parent case serial number 09/444044.

Drawings

The drawings are objected to because:

a) Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated (see page 2 line 14 to page 3 line 14). See MPEP § 608.02(g); and

b) The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "204" and "700" have both been used to designate wireless modem.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

- a) The recitation in page 1 line 19 "GSM modems" is improper, because this acronym has not been introduced previously; it is suggested to be changed to "Global system for mobile communications (hereinafter "GSM")" (see page 7 lines 6-7)
- b) The recitation in page 7 lines 21-22 "wireless modem 208" is improper (see figure 2); it is suggested to be changed to "wireless modem 208" (see page 7 line 6);
- c) The recitation in page 8 lines 1-5 "No special programming is required, however, on the head-end server 216, as only the ASCII strings that comprise a standard SMS message need to be modified (as will be apparent in the description below, in particular with reference to Table 1)" is improper because it is not properly constructed; it is suggested to be changed to "No special programming is required,

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however, on the head-end server 216, only the ASCII strings that comprise a standard SMS message need to be modified (as will be apparent in the description below, in particular with reference to Table 1)" (emphasis added);

d) The recitation in page 10 lines 3-11 "After either step 316 or step 320, the initial processing terminates. It is noted, however, that processing likely involves further steps or specific functions that don't involve the actual handoff or identification of inbound SMS messages. Since such specific processing steps are generally beyond the scope of the invention, they are not further detailed hereinafter, rather, in step 516 it is simply noted that the wireless modem processes the SMS message appropriately" is improper because it is not properly constructed; it is suggested to be changed to "After either step 316 or step 320, the initial processing terminates. It is noted, however, that processing likely involves further steps or specific functions that don't involve the actual handoff or identification of inbound SMS messages. Since such specific processing steps are generally beyond the scope of the invention, they are not further detailed hereinafter, rather, in step 316 it is simply noted that the wireless modem processes the SMS message appropriately" (emphasis added);

e) The recitation in page 16 lines 7-8 "wireless modem 208" is improper (see figure 2); it is suggested to be changed to "wireless modem 204" (see page 7 line 6);

Appropriate correction is required.

The use of the trademark "Hayes" (page 1 line 20) and "MAXIM Integrated Product" (page 17 line 20) have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

Claims 26, 32-49, and 53 are objected to because of the following informalities:

Regarding claim 26, the use the word "if" in line 5 of claim 26 render the claim indefiniteness; it is clear what it happens if the condition is met, but if that condition is not met is indefinite (see 35 USC § 112 second paragraph). It is suggested to change the word "if" to "when".

Regarding claim 32, the use the word "if" in lines 5 and 7 of claim 32 render the claim indefiniteness; it is clear what it happens if the condition is met, but if that condition is not met is indefinite (see 35 USC § 112 second paragraph). It is suggested to change the word "if" to "when".

Regarding claims 33-40, they are objected, because they depend directly from claim 32 and claim 32 is objected.

Regarding claim 41, the use the word "if" in lines 5 and 7 of claim 41 render the claim indefiniteness; it is clear what it happens if the condition is met, but if that condition is not met is indefinite (see 35 USC § 112 second paragraph). It is suggested to change the word "if" to "when".

Regarding claims 42-49, they are objected, because they depend directly from claim 41 and claim 41 is objected.

Regarding claim 53, the use the word "if" in line 5 of claim 53 render the claim indefiniteness; it is clear what it happens if the condition is met, but if that condition is not met is indefinite (see 35 USC § 112 second paragraph). It is suggested to change the word "if" to "when".

Claim 40 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitations of claim 40 are already disclosed in claim 32, and the new recitation that a wireless modem receives the message from a wireless communication network is inherent to the SMS message, because SMS messages come from a wireless network.

Claim 49 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitations of claim 49 are already disclosed in claim 41, and the new recitation that a wireless modem receives the message from a wireless communication network is inherent to the SMS message, because SMS messages come from a wireless network.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 56-60 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 56, claim 56 claims "A data structure in a device-readable medium comprising: a short message service message, the short message service message including modem management information" is not statutory, because it is claiming a data structure that is not claimed as embodied in computer-readable media, and data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer (see MPEP 2106.01; see also specification page 18 lines 3-7 and claims 15-22 of the parent application serial number 09/444044). Claim 56 is claiming a data structure. The medium is in the preamble and the body of the claim does not refer back to the medium, therefore we are left just with a data structure. Data structures per se are not statutory.

Regarding claims 57-60, they are rejected, because they depend directly from claim 56 and claim 56 is rejected.

Regarding claim 57, claim 57 is claiming a signal (is claiming a data structure in an RF signal, so is a data structure in a signal) and signal "per se" are not statutory subject of matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 56-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant Admitted Prior Art (AAPA) view of PCCA standard STD-101 Annex f "Data Transmission Systems and Equipment - Serial Asynchronous Automatic Dialing and Control for Character Mode DCE on Wireless Data Services -Annex F: Miscellaneous Commands", PCCA, October 1994, pages 1-10).

Regarding claim 56, AAPA discloses a short message service message, the short message service message (SMS) including information (page 2 lines 14-22). AAPA doesn't disclose that the information is modem management information. STD-101 discloses in the annex f managing information using AT command for wireless modems (pages 1-10). AAPA and STD-101 are analogous art because they are from the same field of endeavor of wireless modem. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate in the SMS messages disclosed by AAPA the management information disclosed by STD-101. The suggestion/motivation for doing so would have been to control the wireless modem remotely using a wireless connection.

Regarding claim 57, AAPA and STD-101 disclose claim 56, AAPA also discloses an RF signal (page 2 lines 14-22, figure 1 block 110).

Regarding claim 58, AAPA and STD-101 disclose claim 56, AAPA also discloses a data storage medium (page 2 lines 14-22, figure 1 block 104).

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Regarding claim 59, AAPA and STD-101 disclose claim 56, STD-101 also discloses wireless modem configuration parameters (pages 1-10). AAPA and STD-101 are analogous art because they are from the same field of endeavor of wireless modem. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate in the SMS messages disclosed by AAPA the management information disclosed by STD-101. The suggestion/motivation for doing so would have been to control the wireless modem remotely using a wireless connection.

Regarding claim 60, AAPA and STD-101 disclose claim 56, STD-101 also discloses a command for wireless modem to perform a function stored internally to the wireless modem (pages 1-10). AAPA and STD-101 are analogous art because they are from the same field of endeavor of wireless modem. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate in the SMS messages disclosed by AAPA the management information disclosed by STD-101. The suggestion/motivation for doing so would have been to control the wireless modem remotely using a wireless connection.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 23-28 and 29 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-6 and 6 respectively of prior U.S. Patent No. US 6697421

B1. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 30 and 31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. US 6697421

B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the new limitations added to the claims: a) a laptop computer with a serial cable and b) a receptacle to receive a line coupled to the external device are disclosed as prior art in the Applicant Admitted Prior Art (AAPA) in page 2 lines 14-22.

Claims 32-39 and 40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15-22 and 15 respectively of U.S. Patent No. US 6697421 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 32-39 and 40 are broader than claims 15-22 and 15 of US 6697421 B1.

Regarding claim 32, claim 15 of US 6697421 B1 discloses receiving a short message service message at a wireless modem; examining the short message service message for modem management information; processing the short message service message at the wireless modem if the short message service message includes the modem management information; and passing the short message service message through the wireless modem if the short message service message does not include the modem management information.

Regarding claim 33, claim 16 of US 6697421 B1 discloses the method of claim 32, said examining comprising parsing the short message service message; and testing the parsed short message service message for a modem management command indicator, the command indicator indicating whether the short message service message includes the modem management information.

Regarding claim 34, claim 17 of US 6697421 B1 discloses the method of claim 32, wherein said processing the short message service message at the wireless modem comprises initializing the wireless modem base upon the modem management information contained in the short message service message.

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Regarding claim 35, claim 18 of US 6697421 B1 discloses the method of claim 32, wherein said processing the short message service message at the wireless modem comprises checking a quality of a wireless signal detected at the wireless modem.

Regarding claim 36, claim 19 of US 6697421 B1 discloses the method of claim 32, wherein said processing the short message service message at the wireless modem comprises handling a request for a call log history.

Regarding claim 37, claim 20 of US 6697421 B1 discloses the method of claim 32, wherein said processing the short message service message at the wireless modem comprises selecting a RF Channel for wireless communications on the wireless modem.

Regarding claim 38, claim 21 of US 6697421 B1 discloses the method of claim 32, wherein said processing the short message service message at the wireless modem comprises authenticating a party sending short message service messages to the wireless modem.

Regarding claim 39, claim 22 of US 6697421 B1 discloses the method of claim 32, wherein said processing the short message service message at the wireless modem comprises initializing communication parameters for event detection and notification.

Regarding claim 40, claim 15 of US 6697421 B1 discloses the method of claim 32, wherein said receiving the short message service message at the wireless modem comprises receiving the short message service message from a wireless communication network.

Claims 41-48 and 49 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15-22 and 15 respectively of

U.S. Patent No. US 6697421 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 32-39 and 40 are broader than claims 15-22 and 15 of US 6697421 B1.

Regarding claim 41, claim 15 of US 6697421 B1 discloses examine a short message service message that is received at a wireless modem for modem management information; process the short message service message at the wireless modem if the short message service message includes the modem management information; and pass the short message service message through the wireless modem if the short message service message does not include the modem management information.

Regarding claim 42, claim 16 of US 6697421 B1 discloses the storage medium of claim 41, wherein the instructions to examine further comprise instructions to cause the processor to: parse the short message service message; and test the parsed short message service message for a modem management command indicator, the command indicator indicating whether the short message service message includes the modem management information

Regarding claim 43, claim 17 of US 6697421 B1 discloses the storage medium of claim 41, wherein the instructions to process the short message service message at the wireless modem further comprise instructions to cause the processor to initialize the wireless modem based upon the modem management information contained in the short message service message.

Regarding claim 44, claim 18 of US 6697421 B1 discloses the storage medium of claim 41, wherein the instructions to process the short message service message at the wireless modem further comprise instructions to cause the processor to check a quality of a wireless signal detected at the wireless modem.

Regarding claim 45, claim 19 of US 6697421 B1 discloses the storage medium of claim 41, wherein the instructions to process the short message service message at the wireless modem further comprise instructions to cause the processor to handle a request for a call log history.

Regarding claim 46, claim 20 of US 6697421 B1 discloses the storage medium of claim 41, wherein the instructions to process the short message service message at the wireless modem further comprise instructions to cause the processor to select a RF channel for wireless communications on the wireless modem.

Regarding claim 47, claim 21 of US 6697421 B1 discloses the storage medium of claim 41, wherein the instructions to process the short message service message at the wireless modem further comprise instructions to cause the processor to authenticate a party sending short message service messages to the wireless modem.

Regarding claim 48, claim 22 of US 6697421 B1 discloses the storage medium of claim 41, wherein the instructions to process the short message service messages at the wireless modem further comprise instructions to cause the processor to initialize communication parameters for event detection and notification.

Regarding claim 49, claim 15 of US 6697421 B1 discloses the storage medium of claim 41, wherein the instructions to receive the short message service message at the

wireless modem further comprise instructions to cause the processor to receive the short message service message from a wireless communication network.

Claims 50-55 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. US 6697421 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the new limitations added to the claims: a) a laptop computer; a serial cable coupled to the laptop computer; and a wireless modem coupled to the serial cable are disclosed as prior art in the Applicant admitted Prior Art (AAPA) in page 2 lines 14-22.

Claims 56-60 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15, 15, 15, 2 and 3 respectively of U.S. Patent No. US 6697421 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 56-60 are broader than claims 15, 15, 15, 2 and 3 of US 6697421 B1.

Regarding claim 56, claim 15 of US 6697421 B1 discloses a short message service message, the short message service message including modem management information.

Regarding claim 57, claim 15 of US 6697421 B1 discloses the data structure of claim 56, wherein said device-readable medium comprises an RF signal.

Regarding claim 58, claim 15 of US 6697421 B1 discloses the data structure of claim 56, wherein said device-readable medium comprises a data storage medium.

Regarding claim 59, claim 2 of US 6697421 B1 discloses the data structure of claim 56, wherein said modem management information comprises wireless modem configuration parameters.

Regarding claim 60, claim 3 of US 6697421 B1 discloses the data structure of claim 56, wherein said modem management information comprises a command for wireless modem to perform a function, stored internally to the wireless modem.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) ITU-V-250-S "Supplement to ITU-T Recommendation V.250 " ITU-T, September, 1998, pages 1-14. Recommendation V.250 codifies the most common commands used by DTE to control DCE with asynchronous DTE DCE connections. Recommendation V.250 also codifies the syntax to be used by standards committees for extending this command set in various ways. There are now many standards based on this command set using the extended syntax, and more are in development. This supplement is a reference document that collects and summarizes information from this work. This supplement has two purposes: Facilitate cooperation between standards bodies; and Inform developers of communications equipment or software. This supplement contains two sections: references; and tables of commands from various sources, sorted by function; and

b) Eggleston (US 5764899 A) discloses systems configured to support one or more user devices such as wireless subscriber units communicating with host processor

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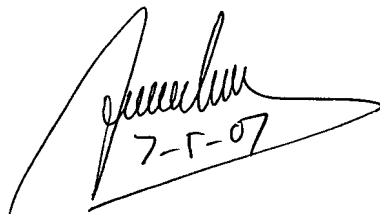
via an infrastructure including base station and intermediate system coupled to a data network (see figures 1 and 2).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Juan A. Torres whose telephone number is 571-272-3119. The examiner can normally be reached on 8-6 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad Ghayour can be reached on 571-272-3021. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Juan Alberto Torres
07-05-2007



7-5-07